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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,329	08/14/2006	Alexander Bublewitz	BUBLEWITZ ET AL-14 PCT	6518
25889	7590	05/18/2010	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1796	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,329

Applicant(s)

BUBLEWITZ ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9, 11-13, 16-21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 11-13, 16-21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 12, 21 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "saturated and an unsaturated (cyclo)aliphatic carboxylic acid" in claim 11 is confusing and lacks antecedent basis in the amended claim 1 in which "saturated and/or unsaturated (cyclo)aliphatic carboxylic acid" has been deleted.

The recited "obtainable" in claim 21 is indefinite and "obtained" is suggested.

The recited "wherein the anion of the catalyst salt b) ---- relative to the carboxyl group" in claim 24 seemed to be redundant and is indefinite in view of the recited particular acids following said clause and said recited particular acids do not show "cycloaliphatic carboxylic acid" at all. Furthermore, claims 12 and 24 are dependent on claim 1 in which particular numbers of carbon atoms are recited, but acids of claims 12 and 24 are silent as to the numbers of carbon atoms and thus it is confusing and indefinite.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 9, 11-13, 16-21 and 23 are rejected under 35 U.S.C. 103(a) as obvious over Yano et al (US 6,077,896) in view of Schwabe et al (US 6,218,461).

Rejection is maintained for reason of record with following response.

Salt forming carboxylic acids taught at col. 6, line 3 would encompass various acids as stated by the examiner and octanoic acid (from tin octanoate, col. 1, line 64) of Schwabe et al would meet the instant unbranched carboxylic acid with at least 5 carbon atoms.

Applicant asserts that the composition of Yano et al would not have the recited setting time and the recited carboxylic acids would provide unexpected result. Said setting time would be based on the recovery after deformation (pp [0039] of the instant published document). But, in response to applicant's argument that the composition of Yano et al would not cure under the conditions in a patient's mouth, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, the conditions in a patient's mouth would be 36.5°C and close to 100% RH which is far more severe than 23°C and 55% RH used by Yano et al and applicant failed to show that the composition of Yano et al would not have the recited setting time under the conditions in a patient's mouth. In fact, the instant example 9 with DBU and 2-ethylhexanoic acid and example 20 with DBU and 2-methylhexanoic acid show a setting time of 7 and 6 minutes, respectively. The originally filed specification failed to disclose that a branched alkyl group of at least

3 carbon atoms and unbranched carboxylic acid with at least 5 carbon atoms would provide unexpected result over a branched alkyl group of at least 2 carbon atoms and unbranched carboxylic acid with at least 4 carbon atoms. Thus, such assertion has little probative value. Even if given the weight to the data in tables 1 and 2 as pointed out by applicant, scope of claim is broader than the showing in tables 1 and 2. Simpler form of acids such as propiolic acid, propionic acid and butyric acid are not compared since the use of carboxylic acids with a smaller molecular weight would be a reasonable start to one skilled in the art.

Claims 1-4, 9, 11-13, 16-21 and 23 are rejected under 35 U.S.C. 103(a) as obvious over Yano et al (US 6,077,896) in view of Schwabe et al (US 6,218,461) and further in view of Bublewitz et al (US 2002/0156186 A1).

Rejection is maintained for reason of record with above response.

Claims 1, 2, 9, 11-13, 16-21 and 23 are rejected under 35 U.S.C. 103(a) as obvious over Yano et al (US 6,077,896) in view of Schwabe et al (US 6,218,461) and further in view of Bachon et al (US 2005/0260401 A1).

Rejection is maintained for reason of record with above response.

Claims 1, 2, 9, 11-13, 16-21, 23 and 24 are rejected under 35 U.S.C. 103(a) as obvious over Yano et al (US 6,077,896) in view of Staiger et al (US 5,304,621).

Again, the instant invention further recites various acids over carboxylic acids of Yano et al. However, the instant acids used to form salts as condensation catalysts are well known as taught by Staiger et al, col. 4, lines 41-51 in which hexanoic acid, 2-ethylhexanoic acid, lauric acid and malonic acid are taught.

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize the carboxylic acids used in forming catalytic salts taught by Staiger et al in forming a salt with DBU of Yano et al since Yano et al teach a salt of DBU with carboxylic acids and since the instant carboxylic acids are well known as taught by Staiger et al absent showing otherwise.

Claims 1-4, 9, 11-13, 16-21, 23 and 24 are rejected under 35 U.S.C. 103(a) as obvious over Yano et al (US 6,077,896) in view of Staiger et al (US 5,304,621) and further in view of Bublewitz et al (US 2002/0156186 A1).

The instant invention further recites reinforcing and/or non-reinforcing fillers with particular BET surface areas over Yano et al and Staiger et al. However, Yano et al teach employing various fillers and a combination thereof at col. 6, lines 23-40.

Bublewitz et al teach the instant fillers in PP [0110]-[0111].

Thus, it would have been obvious to one skilled in the art at the time of invention to further utilize the fillers taught by Bublewitz et al in Yano et al and Staiger et al thereof since Yano et al teach employing various fillers and a combination thereof and since use of the instant fillers with a reactive silyl group containing polyether is well known as taught by Bublewitz et al absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/May 14, 2010